UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,670	01/16/2002	Michael Raley	111325-44	2328

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ART UNIT	PAPER NUMBER
2135	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/046,670	RALEY ET AL.
	Examiner	Art Unit	
	Beemnet W. Dada	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 May 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-75</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-75</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in reply to an amendment filed on May 01, 2007. Claims 1, 37 and

73-75 have been amended. Claims 1-75 are pending.

Response to Arguments

2.   Applicant's arguments filed May 01, 2007 have been fully considered but they are not

persuasive.

3.   Applicant argues that, it would not have been obvious to one of ordinary skill in the art to

combine the teachings of Rabin et al. with Peinado et al., as there is no need to do so, since

Peinado assumes that the rendering engine is trusted and verifies the authenticity of the

rendering engine. Examiner disagrees.

4.   Examiner would point out that In response to applicant's argument that the examiner's

conclusion of obviousness is improper, it must be recognized that any judgment on obviousness

is in a sense necessarily a reconstruction based upon hindsight reasoning. However, a

suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to

be found explicitly in the prior art, as the teachings, motivation, or suggestion may be implicit

from the prior art, as a whole, rather than expressly stated in the references. The test for an

implicit showing is what the combined teachings, knowledge of one of a whole would have

suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 988, 78, USPQ2d 1329,

1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365,1370, 55 USPQ2d 1313 (Fed. Cir.

2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

These showings by the examiner are an essential part of complying with the burden of

presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24

USPQ2d 1443, 1444 (Fed. Cir. 1992). In this case the rendering engine/security module taught

by Peinado could be modified so it would be able to intercept user requests and verify the

validity of usage rights associated with a requested content as taught by Rabin. This

modification would enhance the overall security of the system by providing a second layer of

protection for proper use of content.

5.   Applicant further argues that Rabin et al. does not disclose any type of regulation of

access to the software based on what kind of content is being processed. Examiner disagrees.

6.   Examiner would point out that In response to applicant's argument that the references

fail to show certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., regulation of access to the software **based on what kind of content is

being processed**) are not recited in the rejected claim(s). Although the claims are interpreted

in light of the specification, limitations from the specification are not read into the claims. See *In

re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7.   Applicant further argues that Rabin et al. does not validate check or otherwise process

usage rules associated with content. Examiner disagrees.

8.   Examiner would point our that Rabin teaches a system for protecting information,

including a security module that intercepts requests to a rendering engine that would enact a

violation of usage rights associated with the content [see Rabin, column 11, lines 9-34 and

column 24, lines 33-48], and thus grant or denies the request to access the content based on

the usage rights associated with the content (i.e., **determining the use policy of a tag**

associated with the instance software, and determining if the request is valid by examining the

tag/tag table (usage supervision/rights) and allowing/denying access, see figure 8, steps

275, 276, column 18, lines 10-29).

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et

al. US Patent 6,816,596 (hereinafter Peinado) in view of Rabin et al. US 6,697,948 B1

(hereinafter Rabin).

11.   As per claim 1, Peinado teaches a system for distributing digital documents having

usage rights associated therewith, said system comprising:

        a server having at least one digital document stored thereon [column 2, lines 60-67]

        a client computer having a standard application program including a rendering engine

capable of being accessed to render content [column 3, lines 5-13];

        a communications network coupled to said client and said server [column 2, lines 61-67];

and

        a security module which is downloaded and included in said client computer, the security

module being adapted to be attached to the standard application program for enforcing security

conditions for accessing the rendering engine [column 3, lines 33-67]. Peinado is silent on the system, wherein the security module intercepts requests to the rendering engine that would enact a violation of usage rights associated with the content. However, within the same field of endeavor, Rabin teaches a system for protecting information, including a security module that intercepts requests to a rendering engine that would enact a violation of usage rights associated with the content [see Rabin, column 11, lines 9-34 and column 24, lines 33-48], and thus grant or denies the request to access the content based on the usage rights associated with the content (i.e., determining the use policy of a tag associated with the instance software, and determining if the request is valid by examining the tag/tag table (usage supervision/rights) and allowing/denying access, see figure 8, steps 275, 276, column 18, lines 10-29). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Rabin within the system of Peinado in order to further enhance security of the system.

12.   As per claims 2 and 3, Peinado further teaches the system wherein the security conditions include usage rights associated with the content [column 3, lines 45-56].

13.   As per claims 4, 23-27 and 35-36, Peinado further teaches wherein said security module is operative to determine if said client computer is missing any security component software based on a predetermined configuration required for managing security of requested content and if said at least one client unit is missing any security component software based on said predetermined configuration, said security module is operative to provide said missing security component software to said client computer [column 15, lines 25-50].

14.   As per claims 5 and 32-34, Peinado further teaches the system wherein said security

module is operative to check the content to determine if requested content requires a client side

component of said security module and to disengage the client side security component from

the standard application if the requested content does not require a client side security

component [column 35 line 66 – column 36 line 18].

15.   As per claim 6, Peinado further teaches the system wherein said server comprises plural

server computers and said security module is operative to cause said client computer to

exchange one or more keys with a first of said server computers to obtain a validation

certificate, said validation certificate permitting said client computer to securely communicate

with a second of said server computers without any further exchange of keys between said

client computer and any of said server computers [column 3, lines 5-23].

16.   As per claims 7 and 8, Peinado teaches the system wherein said security module is

operative to define a user interface of said standard application in accordance with parameters

specified by said server [column 14, lines 16-34].

17.   As per claims 9-11, Peinado teaches the system wherein said security module is

operative to superimpose a watermark based on client specific data on a image rendered by

said rendering engine [column 8, lines 3-13].

18.   As per claims 12-17, Peinado teaches the system further comprising a transaction

aggregator system for managing transactions relating to document distribution and wherein said

security module comprises a server side security component that directs the client computer to

the transaction aggregator to receive a client side security component in exchange for

transmitting user information to the transaction aggregator when said client computer makes a

request for content and when said client side security component is not installed in said client

computer, and wherein said transaction aggregator validates said client computer, based on

predetermined conditions, and wherein said client side security component is unique to thereby

identify said client computer to said server and to permit said server to report information

relating to transactions with said client side computer to said transaction aggregator [column 15,

line 58 – column 16, line 15].

19.   As per claim 18-19, Peinado teaches the system wherein said server comprises a

storage device containing a folder of embedded links to digital content and wherein the address

of said folder is selected one of and to be difficult to ascertain, said security module being

operative to provide information relating to at least one of the links when said client computer

sends a request for content to said server and said security module indicates that that said

client computer is authorized to access the content [column 2, line 64 – column 3, line 13].

20.   As per claims 20-22, Peinado further teaches the system wherein said security module

creates a document containing references to the digital content and spawns a child instance of

the rendering engine to render the document, and wherein said child instance of said rendering

engine is operative to follow the references to retrieve content through an asynchronous

protocol from a secured location [column 13, line 59 – column 14, line 16].

21.   As per claims 28 and 29, Peinado further teaches the system wherein said security

component embeds all security information in a header of a document transmitted between said

client computer and said server, said document having a body that does not contain security

information for content in the document [column 19, lines 47-60].

22.   As per claim 30 and 31, Peinddo further teaches the system wherein said security

module is operative to check a request made by said client computer at two stages, a first stage

filter checks if said request corresponds to a prohibited URL and a second stage filter checks if

said request corresponds to a prohibited directory, and wherein if said request corresponds to a

prohibited URL, or if said request corresponds to a prohibited directory, then said request is

denied by said server [column 17, lines 12-37].

23.   As per claims 37-72, the claimed steps correspond to the functions of the elements of

the system claims 1-36, which has been rejected above and thus rejected with the same

reason.

24.   Claims 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado

et al. US Patent 6,816,596 (hereinafter Peinado) in view of Rabin et al. US 6,697,948 B1

(hereinafter Rabin) and further in view of Luckenbaugh et al. US 6,311,269 B2 (hereinafter

Luckenbaugh).

25.   As per claims 73-75, the combination of Peinado and Rabin teaches the claim limitations

as indicated above. Peinado and Rabin teach delivering content, intercepting a security

information and honoring usage rights while processing the content as indicated above.

Peinado-Rabin is silent on the system wherein an HTML header and body, including security

information embedded as recited in claims 73-75. However, within the same field of endeavor,

Luckenbaugh teaches an HTML document adapted to be rendered by Web browser in a secure environment (figure 2B), said document comprising: an HTML header defined between header tags (figure 2B, step 233); an HTML body containing content (figure 2B, step 234); and security information (i.e., Cookie) embedded in said header, said security information being associated with one or more usage rights [figure 2B, step 233 and column 8, line 53 – column 9, line 16]. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Luckenbaugh within the combination of Penado and Rabin in order to render content in an HTML based environment and provide efficient access to content.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Beemnet W Dada

June 28, 2007

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